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EXAMINER

JACKSON, S

ART UNIT

PAPER NUMBER

3738

DATE MAILED:

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/135,222

Applicant(s)
Lau et al.

Examiner
Suzette Jackson

Group Art Unit
3738



☒ Responsive to communication(s) filed on Aug 17, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-32 is/are pending in the application.

Of the above, claim(s) 1-24 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 25-32 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Aug 17, 1998 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3738

DETAILED ACTION

1. Claims 1-24 have been officially canceled.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a) because they fail to show element "11" as described in the specification on page 10, line 1 in Figure 10. Please amend the specification element numbers to correspond to the description given on page 10. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 25-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schatz 5,902,332 in view of Sakura, Jr. 4,214,587. Schatz discloses a longitudinally flexible stent; with a plurality of cylindrical rings (71) aligned on a common axis; which are connected to adjacent rings by interconnecting elements (102); however Schatz does not disclose an undulating pattern or a plurality of projecting edges. Sakura Jr. teaches an undulating pattern with peaks and valleys

Art Unit: 3738

and projecting edges (12). It would have been obvious to one having ordinary skill in the art at the time the invention was made to take the invention of Schatz and modify the cylindrical rings to be in the form of an undulating pattern as taught by Sakura Jr. because it would further allow the prosthesis to "embed" into the arterial wall while still functioning as a support. It also would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the number of connecting elements between the cylindrical rings depending upon where the stent is to be implanted and how much support is necessary and is only a matter of design choice.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 3738

6. Claims 25-32 are provisionally rejected under the judicially created doctrine of double patenting over claims 25-42 of copending Application No. 09/055,582. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

7. The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: Claim 25 of '582 states: A longitudinally flexible stent for implanting in a body lumen, comprising: a plurality of cylindrical elements which are expandable in the radial direction and which are connected so as to be generally aligned on a common longitudinal axis; and at least one weld connection between each cylindrical element to attach the plurality of cylindrical element along the common longitudinal axis thereby forming the longitudinally flexible stent; Claim (26) of '582 states: wherein the cylindrical elements are comprised of a generally sinusoidal pattern. etc. Applicant claims the same features with a change of wording and minor adjustments.

8. Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Art Unit: 3738

9. Claims 25-32 are also rejected under the judicially created doctrine of double patenting over claims 1-23 of U. S. Patent No. 5,514,154 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.


10. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: Claim 1 of '154 states: A longitudinally flexible stent for implanting in a body lumen comprising: a plurality of cylindrical elements which are independently expandable in the radial direction and which are interconnected so as to be generally aligned on a common longitudinal axis; a plurality of connecting element for interconnecting said cylindrical elements, said connecting elements configured to interconnect only said cylindrical elements that are adjacent to each other.....etc.; claim (4) of '154 states: ...plurality of cylindrical elements includes a plurality of peaks and valleys having a serpentine pattern.

11. Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Art Unit: 3738

Conclusion

12. Any inquiry concerning this communication or earlier communication regarding this application should be directed to examiner Suzette Jackson at (703) 308-6516. If you are unable to reach me, please contact my supervisor, Mickey Yu, at (703) 308-2672. In a case requiring immediate assistance, please call (703) 308-0858 to reach the main operator for Sector 3700.



S. Jackson
21 September 1999



David H. Willse
Primary Examiner